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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,276	09/24/2003	Stephen B. Roscoe	58917US002	6568

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EXAMINER

SIEFKE, SAMUEL P

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,276

Applicant(s)

ROSCOE ET AL.

Examiner

Samuel P. Siefke

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/18/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,20,35,36-38 and 42-46 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,20,35,36 and 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/17/04, 2/1/04, 2/6/04, 12/23/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 37-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/18/06.

Claim Objections

Claim 35 is objected to because of the following informalities: They are dependent on a canceled claim. The Examiner is assuming the Applicant intends for claim 35 to depend from claim 1. Appropriate correction is required.

Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18, 20, 35, 36, 42, 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mak et al. (USPN 5,490,415) in view of Bennett, Jr. et al. (USPN 4,511,534).

Mak teaches a diffusion test apparatus that comprises a first base (22) having a plurality of hollow projections (30) extending outwardly from a first surface (12), each hollow projection having a tapered tip (see fig. 2, ref. 26) with an opening (28) therein

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and a respective cavity contiguous with the opening disposed within the projection (fig. 2); a second base (36) having a first surface having a plurality of recessed tapered openings therein adapted to engage the plurality of hollow projections; a membrane contacting the recess tapered openings and the tips of the hollow projections, the first base being fastened to the second base by fasteners (14). The first base and the second base are transparent because they can be made from glass (col. 6, lines 37-39). The fastener means 14 is removable when the membrane is changed. The hollow projections extend through the first base and form an opening at the second surface of the first base (fig. 2 and 3). Regarding claim 5, a first covering means fastened to the second surface of the second base can be seen as plugs 48 that are inserted into the openings 38. Regarding claim 8, the bottom of the first base 22 is an equivalent to the cover 578 of the instant application in that it closes the openings in the first base. The cover plate (bottom of first base) is transparent because it is made from glass. The tapered tips have a beveled proportion (fig. 2). The membrane composition is discussed in column 6, lines 43-50 and can be a synthetic membrane (polymeric), animal, skin, etc.

Mak does not teach a retaining plate for retaining the membrane to the second base.

Bennett teaches a liquid transfer device that comprises a second base 32 and a retaining plate 42 which holds a membrane to the second base 32 by removable fasteners 42 as seen in figure 2-4. Bennett provides this configuration for quick and easy movement of liquid from one container to the next. It would have been obvious to

one having an ordinary skill in the art at the time of the invention of modify Mak to employ the retaining plate 42 of Bennett to allow for moving the membrane and second base to another first base to measure diffusion across the membrane with a second liquid. This configuration would allow the membrane to stay intact with the second base while moving to a second testing liquid which would provide quicker testing of membrane diffusion on multiple sample liquids.

Claims 1-18, 20, 35, 36, 42, 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mak et al. (USPN 5,490,415) in view of Grass (USPN 5,591,636).

Mak teaches a diffusion test apparatus that comprises a first base (22) having a plurality of hollow projections (30) extending outwardly from a first surface (12), each hollow projection having a tapered tip (see fig. 2, ref. 26) with an opening (28) therein and a respective cavity contiguous with the opening disposed within the projection (fig. 2); a second base (36) having a first surface having a plurality of recessed tapered openings therein adapted to engage the plurality of hollow projections; a membrane contacting the recess tapered openings and the tips of the hollow projections, the first base being fastened to the second base by fasteners (14). The first base and the second base are transparent because they can be made from glass (col. 6, lines 37-39). The fastener means 14 is removable when the membrane is changed. The hollow projections extend through the first base and form an opening at the second surface of the first base (fig. 2 and 3). Regarding claim 5, a first covering means fastened to the

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second surface of the second base can be seen as plugs 48 that are inserted into the openings 38. Regarding claim 8, the bottom of the first base 22 is an equivalent to the cover 578 of the instant application in that it closes the openings in the first base. The cover plate (bottom of first base) is transparent because it is made from glass. The tapered tips have a beveled proportion (fig. 2). The membrane composition is discussed in column 6, lines 43-50 and can be a synthetic membrane (polymeric), animal, skin, etc.

Mak does not teach a retaining plate for retaining the membrane to the second base.

Grass teaches a membrane holder that comprises an upper base 14, a retaining plate 18 and a lower base 16. A membrane is placed between the upper base and the retaining plate 18 and held together by means of a threaded connection between the upper base and the retaining plate (col. 3, lines 44-50). The retaining plate is attached to the base plate by bolts 20. It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Mak to employ the retaining plate 18 of Grass to allow for moving the membrane and upper base to another lower base to measure diffusion across the membrane with a second liquid. This configuration would allow the membrane to stay intact with the upper base while moving to a second testing liquid which would provide quicker testing of membrane diffusion on multiple sample liquids.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P. Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sam P. Siefke



November 24, 2006


Jill Warden
Supervisory Patent Examiner
Technology Center 1700